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Paper No.

EWB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Demart Pro Arte, B.V. v. Mike Khemlani

Opposition No. 92,052 to Application
Serial No. 74/320,303 filed October 2, 1992

Victor P. Muskin for Demart Pro Art, B.V.

Mike Khemlani pro se.

Before Hanak, Quinn and Hohein, Administrative Trademark
Judges.

Opinion by Hanak, Administrative Trademark Judge:

Mike Khemlani (applicant) seeks to register DALINI
in the form shown below for "toilet water, perfume, body
lotion, cologne, hair shampoo, hair conditioner and
deodorant for personal use." The intent-to-use
application was filed on October 2, 1992. While
applicant never filed an amendment to allege use, the
record reveals that applicant did make limited sales of
DALINI perfume in 1994.

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On March 26, 1998 Demart Pro Arte B.V. (opposer) filed a second amended notice of opposition. This second amended notice of opposition set forth three claims. First, opposer alleged that it had prior rights in the marks SALVADOR DALI and DALI for a wide array of goods and services. Continuing, opposer alleged that pursuant to Section 2(d) of the Trademark Act, if applicant were to again commence use of its mark DALINI for perfume and related goods, there would exist a likelihood of confusion with opposer's SALVADOR DALI and DALI marks for a wide array of goods and services, and in particular, there would be a strong likelihood of confusion resulting from the contemporaneous use by applicant of DALINI for perfume and the use of SALVADOR DALI for perfume.

Second, opposer alleged that applicant is not entitled to register DALINI because pursuant to Section 2(a) of the Trademark Act, said mark falsely suggests a connection with a deceased person, namely, Salvador Dali. In its second amended notice of opposition, opposer did not specifically allege that it had rights in the name

Salvador Dali. However, opposer's president testified that opposer is the company which possesses the rights to the name and image of

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Salvador Dali. (Descharnes deposition page 1).

Third, opposer alleged that applicant has not used his mark DALINI since October 1994, and accordingly has abandoned his rights in that mark. Oppposer also alleged that applicant no longer has any bona fide intent to use the mark DALINI in commerce.

Applicant filed an answer which denied the pertinent allegations of the second amended notice of opposition.

This case is now ready for final adjudication. Opposer has made of record evidence and filed a brief. Applicant did neither. The record in this case is summarized at pages 4 and 5 of opposer's brief.

We will consider first opposer's Section 2(d) claim. As previously noted, opposer contends that confusion is most likely to occur when applicant's mark DALINI and the mark SALVADOR DALI are both used for the identical goods, namely, perfume. However, this prong of opposer's Section 2(d) claim presents an unusual fact situation

because opposer concedes that "the SALVADOR DALI [perfume] mark is not owned by opposer." (Opposer's brief pages 13-14). However, opposer contends that this lack of ownership is of "no significance" because "opposer derives royalty income from

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[the SALVADOR DALI perfume] mark and [hence] will be damaged by lost sales of SALVADOR DALI fragrance products." (Opposer's brief page 14.)

In support of its contention that it may rely upon the SALVADOR DALI perfume mark simply by virtue of the fact that it receives royalty income from the use of that mark, opposer cites the case of Wilson v. Delaunay, 245 F.2d 877, 114 USPQ 339 (CCPA 1957). In that case, the Court made the following observations: "It is to be noted that the instant proceeding is an opposition and that accordingly the issue is not whether appellee (the opposer) owns the mark in issue or is entitled to register it, but whether it is likely that he would be damaged if the registration of the mark would be granted to the appellant [applicant]. Since appellee [opposer] has been continuously deriving revenue from the use of

the mark on confections since a time prior to its adoption by appellant [applicant], it is evident that the registration of the mark to appellant [applicant] for the same or closely related goods would be likely to damage him." Wilson, 114 USPQ at 341. The Court went on to specifically note that the revenue which opposer had been receiving as a result of the use of the mark in question was

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royalty income. Wilson, 114 USPQ at 341. We also note that more recently Professor McCarthy has taken the same position that an opposer need not own a mark in order to successfully challenge an applicant's application, as demonstrated by the following statement: "The issue is not whether the opposer owns the mark or is entitled to register it, but merely whether it is likely that he [opposer] would be somehow damaged if a registration were granted to the applicant." 3 J. McCarthy, McCarthy on Trademarks and Unfair Competition Section 20:7 at page 20-14 (4th ed. 2001).

In support of its contention that it derives royalty income from the use of the mark SALVADOR DALI on perfume,

opposer relies upon the testimony of its president (Robert Descharnes) and the testimony of the president of a company called Cofci S.A. (Jean-Pierre Grivory). Mr. Grivory testified that Cofci S.A. has been marketing throughout the world perfume under the trademark SALVADOR DALI since 1983. (Grivory deposition page 7). When asked to describe the relationship between opposer and Cofci S.A., Mr. Grivory testified as follows: "[Opposer] is the representative of the rights of Salvador Dali, and we have a relationship with them concerning all the rights of Salvador Dali." (Grivory

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deposition page 8).

Opposer's president Mr. Descharnes was shown a box of perfume bearing the mark SALVADOR DALI and which also bore the trade name Cofci and a portion of opposer's trade name, namely, Demarte. Mr. Descharnes then testified that opposer received royalty income from sale of this SALVADOR DALI perfume. Mr. Descharnes went on to note that said royalty income in United States dollars on an annual basis was in the "seven figure" range. (Descharnes deposition page 8).

Based upon the foregoing testimony and the holding of Wilson v. Delaunay, we find that while opposer does not own the SALVADOR DALI mark for perfume, it has "interests" in said mark which date to 1983. This is approximately nine years prior to applicant's intent-to-use filing date of October 2, 1992.

Having determined that opposer may rely upon the SALVADOR DALI perfume trademark on which to base, in part, its Section 2(d) claim, we now begin our likelihood of confusion analysis.

In any likelihood of confusion analysis, two key, although not exclusive, considerations are the similarities of the goods and the similarities of the marks. Federated

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Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the mark.").

Considering first the goods, they are, in part, legally identical. Applicant seeks to register DALINI

for, among other goods, perfume. As previously noted, opposer has established an "interest in" the SALVADOR DALI perfume trademark dating back to 1983.

Considering next the marks, we note at the outset that when the goods of the parties are identical as is the case here, "the degree of similarity [of the marks] necessary to support a conclusion of likely confusion declines." Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). This is particularly true when not only are the goods identical, but in addition they are ordinary consumer items such as perfume which can be inexpensive. See Specialty Brands, Inc. v. Coffee Bean Distributors, Inc., 748 F.2d 669, 223 USPQ 1281, 1282 (Fed. Cir. 1984) and In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir.

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1984).

At first blush, it would appear that the marks SALVADOR DALI and DALINI are only somewhat similar. However, the record demonstrates that the SALVADOR DALI perfume mark is often referred to as simply DALI per se.

(Grivory exhibit 16, page 61). This is to be expected because the record demonstrates that Salvador Dali was "one of the greatest and most famous" painters of the 20th century. (Descharnes deposition page 2). The great fame of the late Salvador Dali was such that he was often referred to as simply Dali. Our primary reviewing Court, in a case involving clothing and perfumes, noted that when marks consist of given names and surnames, there is a "recognized practice in the fashion industry of referring to the surnames alone." Nina Ricci v. E.T.F. Enterprises, 889 F.2d 1070, 12 USPQ2d 1901, 1903 (Fed. Cir. 1989).

Given this well recognized practice of referring to SALVADOR DALI perfume as simply DALI perfume, it is quite appropriate to compare the abbreviated mark DALI with applicant's mark DALINI. Obviously, in terms of visual appearance, the two marks are quite similar. Applicant's mark incorporates the DALI mark in its entirety and merely

adds the final letters NI. Moreover, in terms of pronunciation, the two marks are also quite similar. In

pronouncing applicant's mark DALINI, one would first have to pronounce the mark DALI, and then add the NI sound.

In sum, given the fact that we are dealing with identical consumer items which can be inexpensive and are purchased with minimal care (i.e. perfume), we find that consumers familiar with SALVADOR DALI or simply DALI perfume would, upon encountering DALINI perfume, assume that the two emanated from a common source. Of course, it need hardly be said that to the extent that there are any doubts on the issue of likelihood of confusion, said doubts must be resolved in favor of opposer whose "interests in" the SALVADOR DALI and DALI perfume marks predate applicant's filing date for its DALINI mark by nine years. In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

However, in this case any doubts that may exist regarding the likelihood of confusion are totally eliminated when one compares the trade dress which applicant selected for his DALINI perfume with the preexisting trade dress for SALVADOR DALI perfume. While it is true that applicant is

not seeking to register his trade dress, nevertheless our primary reviewing Court has made it clear that it is appropriate to consider the trade dress of applicant's product in resolving the issue of likelihood of confusion. Specialty Brands, Inc. v. Coffee Bean Distributors, Inc., 748 F.2d 669, 223 USPQ 1281, 1284 (Fed. Cir. 1984). Indeed, our primary reviewing Court has even stated that the similarity of the trade dress of applicant's product to opposer's product can be a significant factor in determining the issue of likelihood of confusion. See Kenner Parker Toys Inc. v. Rose Art Industries Inc., 963 F.2d 350, 22 USPQ2d 1453, 1458 (Fed. Cir. 1992) ("The multitude of similarities in the trade dress of PLAY-DOH and FUN-DOUGH products cries out for recognition ... The trade dress of the marks enhances their inherently similar commercial impression.")(emphasis added). In this case, the trade dress for applicant's DALINI perfume is even more similar to the trade dress for SALVADOR DALI perfume than was the trade dress for FUN-DOUGH to the trade dress for PLAY-DOH. The packaging for DALINI perfume is exhibit 10 to the Grivory deposition and the packaging for the SALVADOR DALI perfume is exhibit 3 to the Grivory deposition. Not only do both

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sets of packaging share virtually the exact same shade of green, but in addition both sets of packaging have a marbled texture. In addition, on the front panel of both sets of packaging there appears a very simple shape which is outlined in the exact same shade of gold. While the shape is an oval on the DALINI perfume and is a rectangle on the SALVADOR DALI or DALI perfume, their commercial impressions are nevertheless extremely similar. Finally, we simply note that the size of the packaging for both products is virtually the same.

Having found that there exists a likelihood of confusion resulting from the contemporaneous use of the marks DALINI and SALVADOR DALI or simply DALI on identical consumer items which can be inexpensive (i.e. perfume), we elect not to consider the remainder of opposer's Section 2(d) claim. Likewise, we elect not to consider opposer's Section 2(a) claim or opposer's claim that applicant has abandoned its mark DALINI. See American Paging Inc. v. American Mobilphone Inc., 13 USPQ2d 2036, 2039 (TTAB 1989), aff'd 17 USPQ2d 1726 (Fed. Cir. 1990)(unpublished); Goldring Inc. v. Towncliffe

Inc., 234 F.2d 265, 110 USPQ 284, 285 (CCPA 1956).

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Decision: The opposition is sustained.

